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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,646	08/05/2005	Karl M Tischler	P05,0183	7104

26574 7590 05/12/2009

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EXAMINER	
COLILLA, DANIEL JAMES	
ART UNIT	PAPER NUMBER
2854	

MAIL DATE	DELIVERY MODE
05/12/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/534,646	TISCHLER, KARL M	
	Examiner	Art Unit	
	Daniel J. Colilla	2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 February 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *23-41 and 43* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *23-41 and 43* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 2/26/2009 have been fully considered but they are not persuasive of any error in the below rejection.

While Sunada may disclose printing on the tab portion and the separation sheet outside of the tab portion, it is known to solely print on the tab portion of a separation sheet as is disclosed by Motamed *et al.* (see Fig. 10).

Furthermore, while applicant may indicated third data separate from fifth data, the image data disclosed by Sunada *et al.* can be considered separate data as well. Specifically, the data that makes up the image on the tab can be considered third data and the image on the remainder of the separator sheet can be considered fifth data.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 23-25, 27-28, 30-32, 36, 38, 39 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sunada *et al.* (2003/0026626) in view of Motamed *et al.* (US 6,549,300) and Tischer (US 2006/0168518).

With respect to claim 23, Sunada *et al.* discloses the claimed method except for generating at least first data that contain at least information for formatting of elements of at least

one separate sheet and for storing the first data in a first file and except for storing a third data in an additional file.

Sunada *et al.* discloses a method for printing of a separator sheet 52 with a printer or copier 100, comprising the steps of generating and storing a third data in a file, said third data comprising data of the elements to be printed on the register tab (Sunada *et al.*, paragraph [00622], lines 5-8). Although Sunada *et al.* does not explicitly state that the third data is stored in a file, this feature is inherent since the data has been stored in a memory in advance. Additionally, Sunada *et al.* discloses printing at least the register tab of the one separator sheet with the print image by the printer or copier 100 (paragraph [0063]).

Furthermore, Sunada *et al.* teaches processing the third data with aid of a second program module (shown in Figs. 6 and 8 of Sunada *et al.* and mentioned in paragraphs [0067] and [0071]) so that second data are generated (tabbed page insertion positions), and via which with aid of said second data print data for generation of a print image on the register tab are added to a print data stream (Sunada *et al.*, paragraph [0007], Fig. 5).

Motamed *et al.* teaches with the aid of a first program module (as shown in Fig. 13 of Motamed *et al.*), generating at least first data (font type and size) that contain at least information for formatting of elements of at least one separator sheet, said elements to be printed on a register tab associated with the at least one separator sheet; storing the first data in a first file (this is inherent since the data must be stored in a memory in a computer to be accessed when printing). Motamed *et al.* further teaches processing the first data and the third data (the tab text added as shown in Fig. 14 of Motamed *et al.*). It would have been obvious to combine the teaching of

Motamed *et al.* with the printing method disclosed by Sunada *et al.* for the advantage of being able to format the tab text being printed on the tabbed media.

Tischer teaches storing data to be formatted (digital content) in a first file and formatting data (style definition) in a second file. It would have been obvious to combine the teaching of Tischer for the advantage of being able to store commonly used styles so that they can be quickly applied to data to be formatted.

While Sunada *et al.* may disclose printing on both the tab portion and the separation sheet outside of the tab portion, it is known to solely print on the tab portion of a separation sheet as is disclosed by Motamed *et al.* (see Fig. 10). It would have been obvious to one of ordinary skill in the art to apply the teaching of Sunada *et al.* to images that are only printed on the tab portion in view of the teaching for the advantage of printing on mixed sheets as disclosed by Sunada *et al.* in the instances when it is only desired to print on tab portion of a separator sheet and not the remaining portion of the separator sheet.

With respect to claim 24, Motamed *et al.* teaches a first program module (the InsertTabs program, col. 6, lines (42-47) which generate both the third data (Motamed *et al.*, Fig. 14) and the first data (Motamed *et al.*, Fig. 13).

With respect to claim 25, considering different user interface windows as separate program modules, Motamed *et al.* teaches a separate module 500 for generating the third data (Motamed *et al.*, Fig. 14).

With respect to claim 27, Sunada *et al.* teaches image data (data of graphic elements) to as the third data (Sunada *et al.*., paragraph [0062]). Additionally, Fig. 14 of Motamed *et al.* shows that the third data is comprised of text data.

With respect to claim 28, the first data (tab formatting taught by Motamed *et al.*) and the third data (tab label taught by Motamed *et al.* or Sunada *et al.*) are processed for a first print job (document printing) with aid of the second program module (the combining module taught by Sunada *et al.*), the third data being associated with the first print job (since the third data is printed in the first print job, the two are associated). Although not explicitly recited, it would have been obvious to print a second job using, the first data (tab formatting) and fourth data (new tab labels) with the second program module, the fourth data being associated with the second print job (since the fourth data is printed in the second job, the two are associated) since already stored tab label formatting would be a convenient way to format the tabs of a new document.

With respect to claim 30, Sunada *et al.* discloses generation of a print image on a separator sheet outside of the register tab as shown in Figure 9 of Sunada *et al.* The data forming the image in the non-tab region would be the fifth data and the second module would process this data along with the register tab third data.

With respect to claim 31, the second module (shown in Fig. 6 of Sunada *et al.*) indicates that the third data can be selected in step 603. Paragraph [0064] of Sunada *et al.* discloses that the third data can be selected from the image memory 307.

With respect to claim 32, the fifth data is associated with whatever print job is being printed using tabbed separator sheets as shown in Fig. 5 of Sunada *et al.*

With respect to claim 36, the software disclosed by Sunada *et al.* must provide some functions that assist in carrying out the above mentioned processes. These functions would inherently have all the necessary information for the generation of the first data in order for the functions to carry out their intended purpose.

With respect to claim 38, a data processing system is inherently required to carry out the second program module shown in Fig. 6 of Sunada *et al.*

With respect to claim 39, Fig. 8 of Motamed *et al.* teaches wherein the information for formatting contains specification regarding paper format of the separator sheet (tab media size). Additionally, the tab text offset shown in Fig. 11 of Motamed *et al.* would indicate dimensions of the register tab.

With respect to claim 41, Sunada *et al.* discloses the claimed system except for a first data processing system which executes a first program module that generates first data that contain at least information for formatting of elements of at least one separator sheet and for storing the first data in a first file and except for storing a third data in an additional file.

Sunada *et al.* discloses a system for printing of a separator sheet 52 with a printer or copier 100 using third data comprising data of the elements to be printed on the register tab (Sunada *et al.*, paragraph [00622], lines 5-8). Although Sunada *et al.* does not explicitly state that the third data is stored in a file, this feature is inherent since the data has been stored in a memory in advance. Additionally, Sunada *et al.* discloses printing at least the register tab of the one separator sheet with the print image by the printer or copier 100 (paragraph [0063]).

Furthermore, Sunada *et al.* teaches a second data processing system which executes a second program module (shown in Figs. 6 and 8 of Sunada *et al.* and mentioned in paragraphs

[0067] and [0071]) which processes third data so that second data are generated (tabbed page insertion positions), and via which with aid of said second data print data for generation of a print image on the register tab are added to a print data stream (Sunada *et al.*, paragraph [0007], Fig. 5).

Motamed *et al.* teaches with the aid of a first data processing system with a first program module (as shown in Fig. 13 of Motamed *et al.*), generating at least first data (font type and size) that contain at least information for formatting of elements of at least one separator sheet, said elements to be printed on a register tab associated with the at least one separator sheet; storing the first data in a first file (this is inherent since the data must be stored in a memory in a computer to be accessed when printing). Motamed *et al.* further teaches processing the first data and the third data (the tab text added as shown in Fig. 14 of Motamed *et al.*). It would have been obvious to combine the teaching of Motamed *et al.* with the printing method disclosed by Sunada *et al.* for the advantage of being able to format the tab text being printed on the tabbed media.

Tischer teaches storing data to be formatted (digital content) in a first file and formatting data (style definition) in a second file. It would have been obvious to combine the teaching of Tischer for the advantage of being able to store commonly used styles so that they can be quickly applied to data to be formatted.

While Sunada may disclose printing on both the tab portion and the separation sheet outside of the tab portion, it is known to solely print on the tab portion of a separation sheet as is disclosed by Motamed *et al.* (see Fig. 10). It would have been obvious to one of ordinary skill in the art to apply the teaching of Sunada *et al.* to images that are only printed on the tab portion in view of the teaching for the advantage of printing on mixed sheets as disclosed by Sunada *et al.*

in the instances when it is only desired to print on tab portion of a separator sheet and not the remaining portion of the separator sheet.

With respect to claim 43, Figs. 11, 13 and 14 of Motamed *et al.* teach

selecting a template for the separator sheet as said first data; text as said third data for the register tab is selected or loaded;

additional print data as said fifth data for output on said remainder of the separator sheet outside of the register tab is loaded; and

said additional print data as the fifth data is associated with the separator

sheet.

4. Claims 26 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sunada *et al.* (2003/0026626) in view of Motamed *et al.* (US 6,549,300) and Tischer (US 2006/0168518), as applied to claims 24 and 28 above, respectively, and further in view of (Roztocil *et al.* US 2001/0044868).

With respect to claim 26, Sunada *et al.*, in view of Motamed *et al.* and Tischer discloses the claimed method for printing except for storing the second data and the third data being stored in the additional file. However, Roztocil *et al.* teaches storing third data (tab label) and second data (positional information) in the same document data file (Roztocil *et al.*, paragraph [0068]). It would have been obvious to combine the teaching of Roztocil *et al.* with the method disclosed by Sunada *et al.* in view of Motamed *et al.* and Tischer for the advantage of conveniently locating related data in one single file, thus allowing easier file management.

With respect to claim 29, a file name of the first file in which the first data are stored and a file name of the file in which the third data are stored would inherently be specified as parameters in invocation of the second program module in order for the second program module to identify the first and third data properly and process the first and third data.

5. Claims 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sunada *et al.* (2003/0026626) in view of Motamed *et al.* (US 6,549,300) and Tischer (US 2006/0168518), as applied to claim 24 above, and further in view of Barry *et al.* (US 2006/0280538).

With respect to claim 33, Sunada *et al.* in view of Motamed *et al.* and Tischer discloses the claimed method of printing except for the arrangement of elements to be printed on the tabs. However, Barry *et al.* teaches a first data for containing information for arrangement of elements of a separator sheet set to be printed on register tabs as shown in Fig. 17 of Barry *et al.* This figure shows that the rotation and vertical and horizontal alignment of the tab image or text can be specified and stored. In the combination with Sunada *et al.* this data would be added to the print stream by using the second program module for printing a print image on each separate sheet register tab. It would have been obvious to combine the teaching of Barry *et al.* with the method of printing disclosed by Sunada *et al.* in view of Motamed *et al.* and Tischer for the advantage of additional options in the formatting of the image on the register tab.

With respect to claim 34, Fig. 5 of Sunada *et al.* shows the separator sheets 52 acting as a sorting aid in a loose leaf system of document sheets 51.

6. Claims 35, 37 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sunada *et al.* (2003/0026626) in view of Motamed *et al.* (US 6,549,300) and Tischer (US 2006/0168518), as applied to claim 23 above, and further in view of Hanson *et al.* (EP 1246051).

With respect to claim 35, Sunada *et al.* in view of Motamed *et al.* and Tischer disclose the claimed method of printing except that they are silent on whether the first program module is contained as a program element in a desktop publishing program module. However, Hanson *et al.* teaches that teach the first program module is contained as a program element in a desktop publishing program module as a plug-in program module (Hanson *et al.*, Fig. 3, paragraph [0061], lines 1-7). It would have been obvious to combine the teaching of Hanson *et al.* with the method disclosed by Sunada *et al.* in view of Motamed *et al.* and Tischer for the advantage of the convenience of desktop publishing software.

With respect to claim 37, see Fig. 7 and paragraphs [0064, 0068] of Hansen *et al.* that teach a view of the separator sheet with register tab of a separator sheet set with the register tabs is simulated and displayed with aid of the first program module.

With respect to claim 40, see paragraphs [0061-0068] of Hansen *et al.* that teach a preview of a separator sheet with selected settings is possible in the first program module [0061-0064], whereby data with the settings as parameters are transferred to the second program module, the second program module transfers the generated second data to the first program module (software in the computer system includes plurality of program modules that allow setting/generating data for the separator sheet), and with the first program module the second data are further processed into display data with aid of a program element.

7. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sunada *et al.* (2003/0026626) in view of Motamed *et al.* (US 6,549,300) and Tischer (US 2006/0168518), as applied to claim 30 above, and further in view Keane *et al.* (US 6,650,433).

Sunada *et al.* in view of Motamed *et al.* and Tischer discloses the claimed method except for the step of selecting a template as the first data. However, Keane teaches selecting a template (as shown in Fig. 4B of Keane *et al.*) as the first data that provides formatting for a third data (data entered in the form shown in Fig. 4C of Keane *et al.*). It would have been obvious to combine the teaching of Keane *et al.* with the method disclosed by Sunada *et al.* in view of Motamed *et al.* and Tischer for the advantage of providing readily selectable templates with often used preformatted text/image layouts.

Motamed *et al.* teaches loading the text entered into box 504 as shown in Fig. 14 of Motamed *et al.* The fifth data disclosed by Sunada *et al.* would inherently have to be loaded in one respect or another so that it is the computer memory for outputting to the printer. As mentioned above with respect to claim 30, the data forming the image in the non-tab region would be the fifth data.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Daniel J. Colilla** whose telephone number is **571-272-2157**. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Judy Nguyen** can be reached at **571-272-2258**. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

May 13, 2009

/Daniel J. Colilla/
Primary Examiner
Art Unit 2854